

## REMARKS

This Amendment is responsive to the Office Action dated March 19, 2009. In the application Claims 1-19 and 26-29 are pending. Applicant would initially like to thank the Examiner for the withdrawal of the previous pending rejections. In the Office Action, all of the pending claims are rejected in view of Yoon, U.S. Patent No. 5,954,731 (hereafter "Yoon"), alone or in combination with WO Publication No. 00/54662 to Marucci et al. Applicant has carefully reviewed the arguments presented in the Office Action, and respectfully requests reconsideration of the pending claims in view of the remarks presented below.

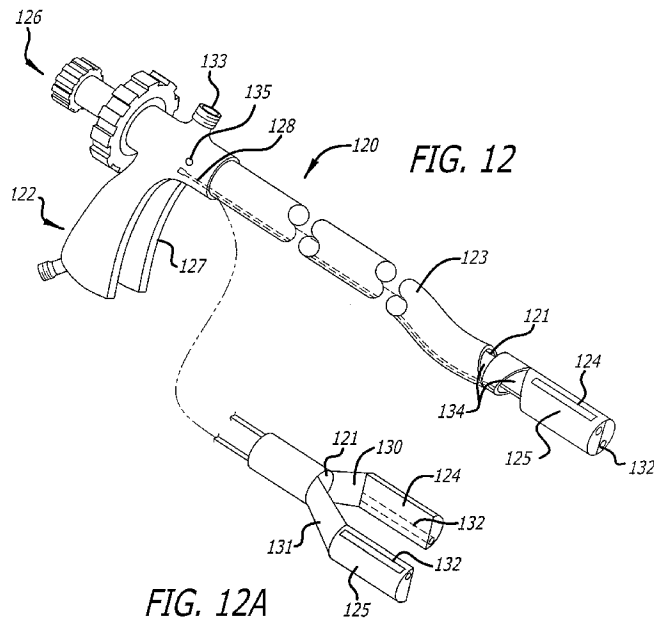
### **Anticipation Under 35 U.S.C. §102**

Claims 1-12, 17-19, 26, and 29 are rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,542,949 ("Yoon"). Claim 1 is reproduced below:

1. A tissue acquisition device, comprising:  
an elongate main body having a proximal end, a distal end, and a length therebetween;  
a first jaw member and a second jaw member each pivotally connected to the distal end of the main body,  
wherein the first and the second jaw members are adapted to move from a first configuration to a second expanded configuration in which the jaw members are translationally positioned into apposition with each other, and  
wherein the first and the second jaw members each define an opening for acquiring tissue therewithin, each opening being in fluid communication with at least one lumen defined in the main body.

The second stanza of the body of the claim includes the following limitation: "the first and second jaw members are adapted to move from a first configuration to a second **expanded** configuration in which the jaw members **are translationally positioned** into apposition with each other." Figure 12 and 12A, shown below, illustrate how the first and second jaw members can be "translationally positioned." Note that jaw members 124, 125 are above and below a centerline, respectively, in Figure 12A and then

translationally move into apposition in Figure 12. This is discussed in paragraphs 43 – 45 of the specification.



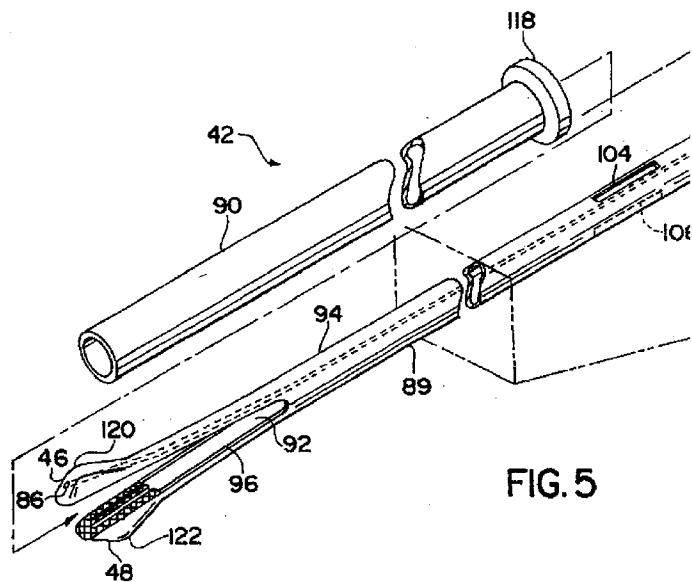
Claim 1 also recites the limitation wherein the first and second jaw members define an opening for acquiring tissue therewithin, each opening being in fluid communication with at least one lumen defined in the main body.

### **Rejection Under 35 U.S.C. §102**

It is black letter patent law that anticipation under 35 U.S.C. §102 requires identity of invention: the claimed invention, as described in appropriately construed claims, must be the same as that of the reference, in order to anticipate. Continental Can Co. USA, Inc. v. Monsanto Co., 948 F.2d 1264, 1267, 20 USPQ2d 1746, 1748 (Fed.Cir. 1991); see also In re Spada, 911 F.2d 705, 708, 15 USPQ2d 1655, 1657 (Fed.Cir. 1990) (“the reference must describe the applicant's claimed invention sufficiently to have placed a person of ordinary skill in the field of the invention in possession of it”).

## Yoon, U.S. Patent No. 5,542,949

Yoon discloses a clip applier instrument that describes a forceps jaws that can apply clips to tissue. An elongate tube **42** forces a pair of spring loaded jaws to pinch together, grabbing tissue. Note that the jaws of Yoon remain in apposition at all times, and do not translate into apposition as required by Claim 1. Further, in no event does Yoon describe his apparatus having a **second, expanded** configuration in which the jaws are positioned translationally **into** apposition with each other as required by the Claim. In order to translate "into" the second, expanded position, the Yoon apparatus must start with a contracted position in which the jaws are not in apposition with each other. This is clearly not the case with the Yoon device. As the Figure below shows, Yoon has two jaw members that simply pinch closed. Accordingly, the limitations of Claim 1 are not satisfied here, where Yoon's jaws fail to translate into apposition, and the Office Action fails to even address this limitation. Because Yoon's jaws do not satisfy Claim 1, the rejection for anticipation based on Yoon is improper and must be withdrawn.



Claim 1 also calls for each jaw member to define an opening for acquiring tissue therewithin. The Office Action in response points to tube 86, but tube 86 does not acquire tissue therewithin. Yoon describes the opening as follows:

"If during a procedure it is desired to evacuate or aspirate **fluid** from the operative site, valve **62** can be coupled with a vacuum source to create suction through the inner cylinder **89** via passages or tubes **86** and **88** which

open at the distal ends of the jaws **46** and **48**, respectively." [Yoon, Col. 7, lines 9 – 13].

Yoon describes an opening for suctioning **fluid**, not tissue, and there is no evidence in the record that would support an anticipation rejection that shows that Yoon teaches openings in the jaw members for acquiring **tissue**. As can be seen from the Figure above, Yoon's openings are far too small to acquire tissue, which is understandable since the openings are designed to suction fluid such as saline, blood, or the like. Accordingly, the rejection based on 35 U.S.C. §102 for anticipation is improper and must be withdrawn on this separate and independent ground.

The §102 rejection based on Yoon is the only rejection of Claim 1 in the Office Action. Applicant has demonstrated that the rejection is faulty for three separate reasons and is properly withdrawn, rendering Claim 1 in condition for allowance. Because Claims 2 – 19 and 26 – 29 depend directly or indirectly from Claim 1, by virtue of Claim 1's allowability these claims are necessarily also patentable over Yoon. Thus, all the pending claims are asserted to be in condition for allowance.

Applicant has demonstrated that all pending rejections cannot be sustained, and that the pending claims are in condition for allowance. Applicant respectfully requests early notification of same. If the Examiner believes that a telephone conference will further the prosecution of this case, the Examiner is invited to contact the undersigned at the number below.

The Commissioner is authorized to charge any deficiencies or fees in connection with this amendment to Deposit Account No. 06-2425.

Respectfully submitted,  
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